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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/043,679

01/11/2002

Kevin Paul McReynolds

PU010147

2531

7590

06/30/2005

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EXAMINER

FILE, ERIN M

ART UNIT

PAPER NUMBER

2634

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,679

Applicant(s)

MCREYNOLDS ET AL.

Examiner

Erin M. File

Art Unit

2634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 0202.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7-10 and 15 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 11-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/11/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
The recitation beginning in paragraph [002], line 3, "both the North American and European DOCSIS standards." The acronym DOCSIS must be properly defined.
2. The use of the trademark DOCSIS® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5, 6, 8, 10, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns et al. and in further view of Ristic et al.

Claims 1, 10, 15, Burns discloses a duplexer (fig. 1, 103) including a low pass filter (118) and a high-pass filter (120). Downstream processing circuitry coupled to the high-pass filter through means of a channel (110, 104, 112, 105, 113, 106, 116) that is coupled to the processor. Upstream processing circuitry is coupled to the low-pass filter (118). Burns fails to disclose a second low pass filter selective coupled to the first low pass filter coupled to the upstream processing. However, Ristic discloses a front end module configured for multi-mode communications in which a switch selectively from a set of filters comprising a first and second low pass filter (figure 6). Further Ristic discloses that the use of multiple filters would be advantageous because it allows multiple frequency bands for upstream processing (description of fig. 4). Because of the advantage of using this type of selectively coupled first and second filter it would be obvious to one skilled in the art at the time of invention to incorporate Ristic's multi-mode filter module into Burn's disclosed apparatus.

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Claims 5, 6, 8, inherit the limitations of Claim 1. Neither Burns nor Ristic specifically disclose high-pass filter passes signals greater than 88 MHz or low-pass filter passes signals less than 65 MHz and the second low-pass filter passes signals less than 42 MHz. According to the Coaxial Networks reference the values of 65 MHz and 42Mhz are the values given as the maximum frequencies for upstream transmission, and 88 MHz is the minimum value of downstream transmission according to the Data Over Cable Service Interface Specification (DOCSIS®) standard. Burns disclosure is used for the processing of cable modem signals (col. 2, line 25). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to choose values for the high pass filter and low pass filters which comply with the internationally accepted DOCSIS® standards for use in a cable modem system.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 7 is rejected under 35 U.S.C. 112 2nd paragraph as vague and indefinite. Claim 7 recites a second selector but there is no first selector recited in Claim 7 or the parent Claim 1.

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7. Claim 9 is rejected because it contains the trademark/trade name DOCSIS®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe telecommunications industry standards and, accordingly, the identification/description is indefinite.

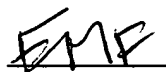
8. Claims 2-4, 11-14 are objected to as dependent upon rejected claim(s), but would be allowable if rewritten in independent form.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erin M. File whose telephone number is (571)272-6040. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin can be reached on (571)272-3056. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Erin M. File



4/29/2005



STEPHEN CHIN
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